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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/774,625	02/10/2004	Masayuki Okamoto	1248-0700P	8685

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EXAMINER	
DUONG, TAI V	

ART UNIT	PAPER NUMBER
2871	

DATE MAILED: 12/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/774,625	OKAMOTO ET AL.	
	Examiner	Art Unit	
	Tai Duong	2871	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *24 September 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *21-54* is/are pending in the application.

4a) Of the above claim(s) *23,25-30,36,37,40,42,46,47,53 and 54* is/are withdrawn from consideration.

5)☒ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *21,22,24,31-34,35,38,39,43 and 48-52* is/are rejected.

7)☒ Claim(s) *41,44 and 45* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☒ Certified copies of the priority documents have been received in Application No. 09/217,931.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *2/10/04;10/1/04*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Applicant's election with traverse of Species A in the reply filed on 09/24/04 is acknowledged. However, there has been no ground of traverse. The requirement is still deemed proper and is therefore made FINAL

Applicant's election of Species A (claims 21, 22, 24, 31-35, 38, 39, 41, 43-45 and 48-52) in the reply filed on 09/24/04 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claims 23, 25-30, 36, 37, 40, 42, 46, 47, 53 and 54 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to nonelected species, there being no allowable generic or linking claim.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 31, 32, 34, 38, 39, 43 and 48-50 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 18 and 46 of U.S. Patent No. 6,281, 952. Although the conflicting claims are not identical, they are not patentably distinct from each other because all of the recited features of the

instant claims are disclosed in the above patent claims. Therefore, the instant claims are broader in scope than the patent claims and are anticipated by the patent claims. Also, it would have been obvious to a person of ordinary skill in the art to broaden the scope of the patent claims by omitting the structure details of the LCD of the patent claims. As to claims 43 and 48-50, the purpose of using color filters of different brightness in the light transmitting and light reflecting display sections is to compensate for differences in the number of times light passes through the liquid crystal layer in the light transmitting and light reflecting display sections, as apparent to a person of ordinary skill in the art.

Claims 24, 33, 35, 51 and 52 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 69 and 73 of copending Application No. 10/177,149. Although the conflicting claims are not identical, they are not patentably distinct from each other because all of the recited features of the instant claims are disclosed in the above claims of the copending application. Therefore, the instant claims are broader in scope than the claims of the copending application and are anticipated by claims 69 and 73 of the copending application. Also, it would have been obvious to a person of ordinary skill in the art to broaden the scope of the claims of the copending application by omitting the structure details of the LCD of claims 69 and 73 of the copending application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: the specification does not disclose the feature "the light reflecting display section has a different transmittance than the light transmitting display section of the corresponding pixel", as recited in claims 21 and 22.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 21, 22, 24, 51 and 52 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 21 is confusing because it is unclear how light can be transmitted at the light reflecting display section because metal is used as the reflective electrode. Therefore, the recited feature "the light reflecting display section has a different transmittance than the light transmitting display section of the corresponding pixel" is unclear. The same reason is also applied to claim 22. The remaining claims are also rejected since they depend on the indefinite claim 21.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section

351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 21 is rejected under 35 U.S.C. 102(e) as being anticipated by Van Aerle et al.

Note Figs. 2-4 which identically disclose the claimed LCD comprising the light transmitting display section 10 and the light reflecting display section 6 (col. 2, line 58 – col. 3, line 14). As apparent to a person of ordinary skill in the art, the light transmittance is substantially zero at the light reflecting display section. Therefore, the light reflecting display section has a *different* transmittance than the light transmitting display section of the corresponding pixel.

Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

Claims 41, 44 and 45 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 22, 24, 51 and 52 are not indicated as allowable over the prior art of record because the intended scope of these claims is unclear as set forth in the above 112 rejection.

Any inquiry concerning this communication should be directed to Tai Duong at telephone number (571) 272-2291.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

TVD

12/04

TOAN TON
PRIMARY EXAMINER